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Remarks

Claims 11-16 are under consideration.

Claim 11 is amended to specify further that the folding rolls of the interfolder coact to produce interfolded sheets of material. No new matter has been introduced by this amendment.

The rejection of claims 11, 14 and 16 under 35 U.S.C. 102(b) as anticipated by Hermach is not warranted, and is hereby traversed.

The Examiner has misconstrued Hermach, because this reference does not disclose an apparatus for interfolding at least two sheets of material. No interfolding is shown by Hermach. Figure 5 of Hermach unequivocally shows that no interfolding is taking place. Stacking folded pieces on top of one another is not interfolding. Second fold rolls 38 (col. 5, lines 2-3; Fig. 2) do not comprise an interfolder. Cf. U.S. Patent No. 5,088,707 to Stemmler which shows a typical interfolder apparatus.

As the Examiner is well aware, anticipation requires that each and every claim element is shown in the applied reference. That clearly is not the case here. Hermach does not show an interfolder. The Examiner's unsupported opinion that "... broadly considering the claimed 'interfolder' for producing 'interfolded sheets of material' could be nothing more than folding the folded sheets stacked on top of each other to form the claimed interfold" cannot support an anticipation rejection. Moreover, it is technically incorrect.

As previously recognized by the Examiner, claims 11, 14 and 16 call for an interfolder that comprises a pair of coacting folding rolls that together produce a stack of interfolded sheets. Interfolders are illustrated by U.S. Patent No. 1,219,239 and U.S. Patent No. 5,088,707, both of record. U.S. Patent No. 3,942,782 to Hermach, on the other hand, does not show an interfolder but a newspaper folding apparatus. Hermach's apparatus does not and cannot produce a stack of interfolded sheets. Hermach's product is shown in FIG. 5 where it can be readily seen that web sections A, B, C, D, E, F are not interfolded but merely stacked one on top of another. That is not interfolding. Independent claim 11 expressly calls for rolls that co-act to produce interfolded sheets of material.

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Hermach only shows a single folding cylinder (cylinder 36) downstream from folding boards 26A-26C. The present claims call for an interfolder that comprises a pair of coacting folding rolls. A single folding cylinder as shown by Hermach cannot possibly interfold sheets of material.

Cylinder 37 is not a folding cylinder but a cutting cylinder, see col. 4, lines 67-68, for separating individual newspaper sections that then pass through rollers 38 and are individually placed into pockets of delivery fan wheel 39 for deposit on conveyor 40. See col. 5, lines 1-4 and FIG. 2. Second fold rollers 38 do not constitute an interfolder because rollers 38 do not coact to produce an interfolded product. Rollers 38 fold the entire newspaper. See, for example col. 4, line 64 to col. 5, line 14.

Cross-folding of a collated newspaper does not produce a stack of interfolded sheet material. See FIG. 5. Also, as can be seen in FIG. 2, rollers 38 are spaced from one another.

This anticipation rejection of claims 11, 14 and 16 is not supported by the record and should be withdrawn.

Specifically with respect to claim 14, this claim calls for knife rolls situated between the dispensers and the pair of folding rolls of the interfolder. No such elements are shown in Hermach.

Specifically with respect to claim 16, inasmuch as Hermach does not show an interfolder with a pair of folding rolls that receive therebetween preformed sheet material, there can be no anticipation of claim 16.

The alternative rejection of claims 11 and 13-16 under 35 U.S.C. 103(a) as unpatentable over Stemmler in view of Hermach is likewise unwarranted, and is traversed as well.

The Examiner concedes that the sheets disclosed by Stemmler lack the longitudinal fold line as well as the fold (Office Action, page 3). Stemmler teaches very different expedients. Stemmler teaches the production of numerically correct stacks of interfolded sheets, an event that takes place downstream from the folding rolls. One of ordinary skill would not have had any motivation whatsoever to look upstream of the folding rolls when seeking to improve upon Stemmler's apparatus.

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The shortcomings of Stemmler as a reference against the appealed claims is not cured by Hermach. This particular reference merely shows an apparatus for folding (not interfolding) newspaper pages.

Stemmler and Hermach are not combinable in any event. Hermach describes an apparatus for folding newspapers. That has nothing to do with interfolding webs of material. There is no reason whatsoever to interfold a newspaper, thereby making it more difficult to unfold for reading. One of ordinary skill most certainly would not have done so. Besides, the mechanical elements of Hermach's apparatus are vastly different from those of Stemmler (Cf., for example, FIG. 1 of Stemmler with FIG. 2 of Hermach).

It is also improper, as here, to use the appellant's own specification as an instruction book on how to reconstruct the prior art. Panduit Corp. v. Dennison Mfg. Co., 1 U.S.P.Q.2d 1593, 1602 note 29. One of ordinary skill would not have had the appellant's own specification as a guide for assembly at the time this invention was made.

To properly combine the references, there must be some teaching, suggestion or inference in the references themselves that would have led one of ordinary skill in the relevant art to combine the appropriate teachings. That is not the case in this instance.

Here neither Stemmler nor Hermach provide the requisite motivation to pick, choose and assemble the claimed apparatus. The Examiner has failed to provide a rationale for the attempted combination of references. Stemmler is concerned about producing numerically correct partial stacks from individual sheets interfolded in conventional manner. Stemmler focuses the attention of one of ordinary skill downstream from the folding rolls to which webs W1 and W2 are fed conventionally. Stemmler indicates no need for an upstream modification of webs W1 and W2. Hermach seeks to expedite the folding and collation of newspaper pages, and has devised an apparatus expressly designed to do so. Hermach, however, does not and cannot interfold newspaper pages. That would have resulted in a product totally unacceptable to the reading public.

Neither Stemmler nor Hermach address the problem (compact packaging) recognized, addressed and solved by the appellant.

Regarding claims 13-16, the mere fact that isolated claim elements can be found in the prior art does not vitiate the patentability of these particular claims.

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The rejection of claim 12 as unpatentable over Stemmler in view of Hermach and further in view of DuFresne is traversed as well.

The Examiner concedes that neither Stemmler nor Hermach disclose a double "c"-shaped fold as called for in claim 12. Neither does DuFresne. The double "c"-shaped fold is illustrated in appellant's FIGURE 3(a) at 118. Nothing of the kind is shown by Stemmler, Hermach or DuFresne. Only zig-zag folds are shown by DuFresne and Stemmler. See, for example, FIG. 3 of DuFresne and FIGS. 6 & 7 of Stemmler.

The Graham requirements for obviousness have not been satisfied vis-a-vis claims 11-16. In KSR International Co. v. Teleflex, Inc., 82 U.S.P.Q.2d 1385, 1397 (2007), the Court explained and affirmed the analysis required to support an obviousness rejection under Section 103(a) by stating that the factual inquiries enumerated in Graham v. John Deere Co., 383 U.S. 1 (1966), are the basis for this purpose. These required factual inquiries are not supported by the record in this case to justify a rejection based on obviousness.

In particular, the relevant prior art is paper converting art as it pertains to apparatus for interfolding at least two sheets of material to form a web of interfolded sheets. Only one of the applied references, Stemmler, pertains to this art. Hermach, the other reference, pertains to apparatus for folding, not interfolding, of newspapers. As noted hereinabove, one of ordinary skill would not have had any reason to interfold a newspaper, thereby making the newspaper difficult, if not impossible, to read.

As to the differences between the claimed invention and the prior art, the Examiner has focused on similarities rather than differences. The Stemmler apparatus and the Hermach apparatus are each designed and built for a different purpose and a different product. The Examiner's contention that one of ordinary skill would have looked to Hermach to improve Stemmler's apparatus lacks the necessary factual underpinnings. As appellant has pointed out time and time again, interfolding has been known for close to 100 years as evidenced by U.S. Patent No. 1,219,239 (1917) of record, yet prior to appellant's invention a folding device upstream of the interfolder rolls has not been utilized. As is well established, the claimed invention must be looked at as a whole. In determining obviousness it is not relevant that some aspects of the claims may have been otherwise known in the art. Jones v. Hardy, 220 U.S.P.Q. 1021, 1025 (Fed. Cir. 1984). Virtually all inventions are necessarily

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combinations of old elements. One cannot pick and choose among individual parts of assorted prior art references as a mosaic to create a facsimile of the claimed invention. Akzo N.V. v. United States ITC, 1 U.S.P.Q.2d 1241, 1246 (Fed. Cir. 1986).

Specific lack of factual underpinnings for dependent claims 12-16, inclusive, are enumerated hereinabove.

The level of ordinary skill in the pertinent art remains unresolved. No findings for this particular prong of the Graham inquiries are of record or can be supported by the record.

Objective evidence of unobviousness stands un rebutted. Specifically, the nomination for the IDEA Achievement Award is evidence of unobviousness.

No factual basis for the legal conclusion of obviousness has been established in this case.

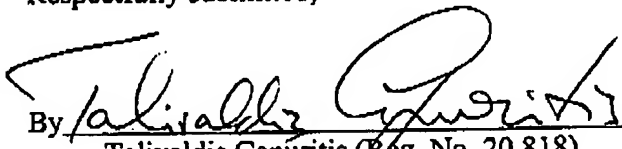
A prima facie case of obviousness has not been established. One of ordinary skill would not have even attempted to interfold a newspaper. The selection of Stemmler and Hermach as references in this case clearly has been arrived at by impermissible reliance on the appellant's own specification for guidance. In any event, even the attempted combination of references would not have made the present invention obvious to one of ordinary skill in the art.

The Graham requirements have not been met.

The rejection should be withdrawn.

Respectfully submitted,

May 27, 2008

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Talivaldis Cepuritis (Reg. No. 20,818)